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Application of HAYNES *et al.*
09/459,189
Docket No. 4173/2

REMARKS

Claims 1-25 are pending in this application. Claims 1-25 have been rejected under 35 U.S.C. §103. Applicants respectfully traverse.

Acknowledgment of Citations

Applicants respectfully note that Examiner does not appear to have acknowledged consideration of the non-patent references cited in the Information Disclosure Statement filed herein 17 December 2002 by Applicants. Applicants respectfully request that Examiner acknowledge his consideration of those references.

Previous re-writing of claims

Applicants acknowledge and concur with the Examiner's observation that the previous re-writing of the claims was solely grammatical or typographical, and that they do not change the scope of the claims as originally presented.

Rejection of the Claims under 35 U.S.C. §103(a)

The Examiner has re-entered the rejections of the claims on grounds stated in the Office Action in Paper 11 in this application. Applicants respectfully transverse, as explained below.

Claims 1, 4 - 9, and 17 - 25

Claim 1 and claims 4-9, each of which depends from claim 1, are drawn to a computer-based system for truck rentals, comprising, among other things, a server; memory in which is stored data relating to trucks and to towing accessories, and expertise-based guidance relating to trucks and towing accessories; and programming for processing user inputs and the data relating to the trucks and towing accessories to access the memory and provide expertise-based guidance to a user computer over the communications network.

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Neither Danford-Klein *et al.* nor U-Haul disclose or suggest such systems, either alone or in combination. For example, neither Danford-Klein nor U-Haul disclose or suggest any systems for using user input and stored data to provide expertise-based guidance to a user computer. At most, the cited references teach providing lists or menus of items which may be rented, without using expertise-based guidance to guide or assist the user, for example, in making an equipment selection.

For example, U-Haul provides a list of information relating to towing accessories. U-Haul does not, however, teach or suggest using user input and stored data relating to accessories to recommend the use of a particular towing accessory to transport a particular car identified by the user as part of the user's input. U-Haul provides lists of accessories without making recommendations for the user of particular accessories, or consideration whether the accessories in the provided list are suitable for any particular vehicle. Applicants' claimed expertise-based guidance provides much more, such as specific recommendations based on specific vehicle types (see, e.g., page 16, line 17, to page 20, line 18, and Figures 10, 11, 14, and 15).

Applicants respectfully submit that the cited references do not render their invention obvious, and request reconsideration and withdrawal of the rejection. Applicants further respectfully maintain the reservation of rights to challenge the authenticity of this U-Haul reference stated in their response to the 10 June 2002 office action.

Applicants respectfully submit that Claims 17 – 25 are allowable for at least these same reasons, and respectfully request reconsideration and withdrawal of those rejections also.

Claim 2

Claim 2 recites an improvement, in a computer-based system for truck rentals, comprising a memory including data relating to towing accessories and towed vehicles, and programming which, in response to user identification of a vehicle to be towed, provides data indicating availability or unavailability of a towed accessory for the identified vehicle.

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The examiner acknowledges that Danford-Klein and U-Haul collectively fail to teach this limitation, but asserts without further explanation that it would have been obvious to one of ordinary skill in the art to expand the "collective system taught by Danford-Klein and U-Haul to provide the claimed functionality." The Examiner states that his finding is based only on the level of ordinary skill at the time the invention was made. The Examiner provides no evidence other than the cited references as to what the level of ordinary skill at that time was. As Applicants have previously stated, the level provided by the cited references is not sufficient to render Applicants' claimed invention obvious.

It is well settled that in order to establish a case of obviousness the cited references must suggest the desirability of making the combination of references to make the claimed invention, and that the references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention. See, e.g., MPEP 2141.01. Here there is nothing whatever in either of the cited references to suggest the desirability of providing the missing features to make Applicant's claimed combination, or even to combine the teachings of the cited references at all; and the Examiner has provided no further evidence of the state of the art at the time the invention was made. Danford-Klein, as indicated in Applicants' earlier responses, teaches entirely away from both Applicants' claimed invention and the U-Haul system. The lacking features of the cited references could only be supplied by impermissible hindsight, in view of Applicants' own claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 3 and 15

With respect to Claims 3 and 15, Applicants respectfully submit that the claimed functionality of using computer programs to provide multiple pick-up and drop-off locations for rental vehicles is not at all analogous to the problems addressed by Danford-Klein and applied by the Examiner in making out the obviousness rejection; and provides no motivation or guidance for using U-Haul to provide Applicants' claimed invention.

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Danford-Klein is concerned with the pick-up, transportation, and delivery by common carriers of goods specified by parties to contracts, at locations specified by the parties. The goods to be delivered are not stated to be fungible in any degree, and therefore are, within the contemplation of the reference, available only at one identified location. Applicants' invention, as claimed and disclosed, provides a renter with options in vehicle pick-up and drop-off locations that are not possible, and not contemplated, by the Danford-Klein system. For example, if similar or mutually-suitable trucks are available to a prospective renter in a plurality of locations, Applicants' invention provides the renter a choice in the location from which the renter wishes to pick up and/or return a truck. This is not at all similar to picking up goods from a single, specified location.

Again, the Danford-Klein - U-Haul combination lacks claimed features, and there is nothing in either of the references to provide any motivation for providing the missing features, either by combination of the references or by any other means.

Applicants respectfully request reconsideration and withdrawal of the rejections.

Claims 10 and 11

With respect to Claims 10 and 11, Applicants respectfully submit that the claimed functionality of using computer programs to provide closest pick-up and drop-off locations, directions, and other information is not at all analogous to the problems addressed by Danford-Klein, U-Haul, and or Brandt and applied by the Examiner in making out the obviousness rejection, for reasons similar to those stated above. Moreover, as the Examiner has acknowledged, several of the claimed features, including those listed above, are lacking entirely in the cited art.

With all due respect, the Examiner has again provided no basis for his assertion that provision of the lacking features would be obvious to one of ordinary skill in the art. Again, Applicants respectfully request that the Examiner produce evidence to that effect, or support for his statement.

In absence of such evidence or support, Applicants respectfully request reconsideration and withdrawal of the rejection.

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Claims 12 and 16

Claim 12 is directed to a system for aiding users to create and confirm reservations for truck rentals which includes among other features a web server for providing a plurality of web pages and for processing user inputs received from a user's computer operating a browser displaying the plurality of web pages which include at least one input field for receiving the user inputs, and a web page including data fields providing all information which the system provides to a user information necessary for a service contract in response either to user input data or data available from the system in which all data fields may be modified on the web page by the user without having to revert to another web page.

Claim 16 is drawn to a method for aiding users to create and confirm reservations for truck rentals comprising, inter alia, generating a reservation form on a web page which contains all reservation information provided in response to user input which may be changed by the user directly on the form on that web page without having to access another web page.

The Examiner has acknowledged that both Danford-Klein and U-Haul fail to disclose, either singly or in combination, a web page including data fields providing all information which the system provides to a user information necessary for a service contract in response either to user input data or data available from the system in which all data fields may be modified on the web page by the user without having to revert to another web page. Moreover, as previously indicated, neither Danford-Klein nor U-Haul provides any motivation for combination of the references to provide any of Applicants' claimed features.

Again, entire features of the claimed invention are lacking in the cited art, and no motivation exists for combination of those features which are taught. The reservation page taught by U-Haul is not the same as a contract page, and it is not analogous for relevant purposes. As is clear to anyone who has purchased goods or services over a computer network, a great deal more information, much of it secure, is required for the completion of a goods or services contract, and space on any single web page is limited. Neither U-Haul nor Danford-Klein (nor any other cited references) provides any

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guidance to solving the problems addressed by Applicants' invention, or suggests any solution.

Applicants respectfully request reconsideration and withdrawal of the rejections.

Claim 14

Claim 14 is drawn to a computer-based method for truck rentals which provides truck availability and pricing information, the improvement comprising the steps of providing towed vehicle identification data to the user, receiving a towed vehicle selection, determining whether an accessory is available for the particular selected vehicle, and informing the user of the result of the determination.

Neither Danford-Klein et al. nor U-Haul disclose or suggest such systems, either alone or in combination. Neither Danford-Klein nor U-Haul disclose or suggest any systems or methods for determining whether a suitable towing accessory is available for a particular, identified vehicle. Neither Danford-Klein or U-Haul discloses or suggests any method or system for eliciting information relating to a particular vehicle, much less using such information to identify a suitable towing accessory or determine whether such an accessory is available to the user.

For reasons already discussed, Applicants submit that the cited art does not render the claimed invention obvious, and respectfully request reconsideration and withdrawal of the rejection.

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CONCLUSION

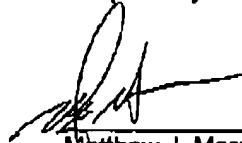
Applicants believe that they have fully responded to each of the concerns expressed by the Examiner in the Office Action, and that each of the pending claims is in condition for allowance. Applicants respectfully request allowance of the claims.

Applicants request that any questions concerning this matter be directed to the undersigned at (212) 805-2906.

I hereby certify that this paper, together with any document referred to as attached or enclosed, is being deposited this date with the U.S. Postal Service, with sufficient postage, as First-Class Mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

Date: 17 July 2003



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